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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91163791
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, LLC,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

TRIAL BRIEF OF OPPOSER

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B. DESCRIPTION OF THE RECORD

Opposer has submitted:

- (1) Testimonial Deposition of Richell Bennett ("Bennett Tr."), taken on June 5, 2008, and Opposer's Exhibits (hereinafter "OX") 1 – 34D;
- (2) Testimonial Deposition of Michael Kinnen ("Kinnen Tr."), taken on June 5, 2008, and OX 35A – 35F;
- (3) Discovery produced by Applicants [OX 36 – 42], *see* chart for specific exhibits, attached hereto as Attachment A;
- (4) Status and Title copies of Opposer's U.S. registrations [OX 43 - 58], *see* chart for specific exhibits, attached hereto as Attachment B;
- (5) Sampling of printed publications for the years 2000-2007 [OX 59 – 64];
- (6) Copies of agreements entered into by Opposer, and submitted to the Board on October 16, 2008 as Exhibits A-C to Joint Stipulation Regarding Evidence; and
- (7) Pursuant to 37 C.F.R. §2.122, the U.S.P.T.O. file of the opposed Application, Serial No. 78/264,260, also is of record.

Applicant has submitted:

- (1) Testimonial Deposition of Mark Lamb ("Lamb Tr."), taken on August 28, 2008 and Applicant's Exhibits (hereinafter "AX") 1-10;
- (2) Copies of third party registrations (subject to Opposer's Objections), [AX11-21]; and
- (3) Copies of Internet publications (subject to Opposer's Objections), [AX22-52].

II. STATEMENT OF FACTS

A. OPPOSER BIG O TIRES

1. The Big O Tires Story

Big O Tires was founded in the early 1960's as a tire-buying cooperative, banding together to compete against tire manufacturers' company stores and big retail chains. Bennett Tr. 11:8-16, OX10 ("The Big O Tires Story"). With the dramatically increasing sales of motor vehicles and related products, Big O Tires quickly evolved from a place where someone could purchase new (replacement) tires for their motor vehicle, into a major retail store, vehicle service and franchising organization. OX 10. Today, Big O Tires essentially wears two hats. It is a wholesale distributor of the **BIG O TIRES** brand line of tires, as well as other major brands of tires, wheels and automotive parts. Big O Tires also is North America's largest independent tire franchiser. Bennett Tr. 9:13-20. It has more than 540 stores located in twenty one (21) states throughout the Mid-West and West of the Mississippi River. Bennett Tr. 11:21-12:22, OX 1A-1G, OX 10.

2. The Big O Tires Business Model

Big O Tires sells and services its own private brands of tires, as well as offering retail store services and vehicle maintenance and repair services under the **BIG O**, **BIG O TIRES** and **BIG FOOT** marks (collectively, the "**BIG O TIRES Mark**"). Big O Tires has been selling tires under the **BIG O TIRES Mark** for well over four decades. Bennett Tr. 11:8-16, OX43-50, 52-58. In addition to selling its private brand tires, as well as a significant selection of major national brands of tires, Big O Tires sells custom wheels, brakes, shock absorbers, struts and assorted parts. Bennett Tr. 9:21-24, OX3, 5A-B, 6A-6I.

Big O Tires sells and installs custom wheels at its Big O Tires stores. Bennett Tr. 9:21-24; OX3; OX10; OX 40, nos. 52-53. Indeed, it is common for Big O Tires stores to have custom wheel displays. Bennett Tr. 15:25-16:3, OX3. At least as early as 1998, Big O Tires published BIG O TIRES Wheel Catalogs. Bennett Tr. 17:13-21, OX5A-5B. Subsequently, wheels were promoted in Big O Tires's product catalogs. Bennett Tr. 17:13-19:19, OX6A-6I. Custom wheels are also promoted on Big O Tires's website, located at www.bigotires.com (the "Big O Tires Website"). Bennett Tr. 27:15-16; OX10. In fact, Big O Tires's sale of custom wheels is a "definitely a strong part of the business". Bennett Tr. 15:25-16:3

Big O Tires also provides basic installation, maintenance and/or replacement services for motor vehicles, including tire installation, tire alignment, brake work, oil changes (and, in connection therewith, oils and lubricants). Vehicle repair and maintenance services are available at all of Big O Tires's retail locations. Bennett Tr. 9:25-10:9, 13:8-10.

As the nation's largest independent tire franchiser, Big O Tires provides excellent support for its prospective and actual franchisees. For example, Big O Tires offers initial training at Big O University. Additional training opportunities are provided regionally, as well as on the Internet. Bennett Tr. 10:10-23.

For the last decade, the **BIG O TIRES Mark** also has been prominently featured on a credit card which Big O Tires issues to its customers. Bennett Tr. 36:4-37:25; OX13A-C, OX14.

3. Use and Registration of the BIG O TIRES Mark

Since its very earliest days, Big O has used its **BIG O TIRES** trade name, trademark and service mark, alone, and as a house mark in connection with the operation of its large network of retail tire stores and the sale at wholesale and at retail of vehicle parts and accessories, and related

motor vehicle care services. Bennett Tr. 11:1-16. Opposer's **BIG O TIRES Mark** primarily is used in every facet of the Big O Tires business, and every facet of the Big O Tires stores. Bennett Tr. 13:11-22.

Big O Tires is the owner of the following U.S. trademark and service mark registrations for its **BIG O TIRES Mark**:

<u>MARK</u>	<u>REG'N NO.</u>	<u>ISSUE DATE</u>
BIGFOOT COUNTRY	2,927,656	February 22, 2005
BIG O TIRES & Bigfoot Design	2,834,058	April 20, 2004
Bigfoot Design	2,821,055	March 9, 2004
Bigfoot Design	2,821,054	March 9, 2004
BIG O TIRES & Bigfoot Design	2,821,053	March 9, 2004
Bigfoot Design	2,821,052	March 9, 2004
Bigfoot Design	2,821,051	March 9, 2004
WWW.BIGOTIRES.COM	2,514,975	December 4, 2001
BIG O TIRES	2,411,926	December 12, 2000
BIG FOOT	1,904,955	July 11, 1995
BIG O TIRES & Design	1,611,160	August 28, 1990
BIG FOOT 70	1,102,059	September 12, 1978
BIG FOOT 60	1,102,058	September 12, 1978
BIG O	994,466	October 1, 1974
BIG-O	993,415	September 24, 1974

OX 43-50, OX52-58.

4. Advertisement and Promotion of the **BIG O TIRES Mark**

Big O Tires and Big O Tires's franchisees use the **BIG O TIRES Mark** on signage, as well as on posters and banners displayed in the retail stores, as well as outside the stores. Bennett Tr. 13:11-22; OX2. All Big O Tires retail locations have the **BIG O TIRES Mark** on the exterior of the store. Bennett Tr. 13:11-22, 14:24-15:15:3. The **BIG O TIRES Mark** even appears on courtesy shuttle buses used by many of the retail store locations which offer shuttle service for its customers. Bennett Tr. 16:7-23, OX4, p.3. The **BIG O TIRES Mark** appears, and are used, on point-of-sale

catalogs and directories used by franchisees and consumers, as well as branded give-aways, such as pens, plastic cups, and apparel. Bennett Tr. 20:2-20; OX7A-7G. The use by franchisees of these materials all help in the overall goal of providing a national uniform brand image. Bennett Tr.21:9-17.

Big O Tires maintains a national marketing fund: a program that its marketing department administers for the benefit of its franchisees. With its national marketing fund, Big O Tires produces national radio and television spots, as well as point of purchase kits which are distributed to its franchisee groups to support different promotions during the course of the year in seasonal selling periods, along with a number of other programs. The point of purchase kits consist of banners, brochures, counter cards, rebate pads, and all kinds of miscellaneous type items that would support either a consumer promotion or a selling season that was occurring. Some of the activities associated with Big O Tires's charity events are funded with Big O Tires's national marketing fund, as well. Bennett Tr.23:8-25:5,29:10-33:6; *see e.g.*, OX4, 7A-G, 8A-E.

A recent search of the eBay internet shopping website with respect to the search term "Big O Tires" returned various BIG O TIRES branded items produced over a range of dates. For example, the search returned a vintage "Big O Tires" patch. Other items identified included: a "Big O Tires" racing patch, a shirt reflecting Big O Tires's sponsorship of racing at Infineon Raceway, a direct mail postcard, a plush doll, and the like. Bennett Tr. 70:14-71:15, OX31.

A search was conducted of the Yahoo Internet search engine with respect only to "tires" in the area of Scottsdale, Arizona, a suburb of Phoenix, Arizona. In this market area, Big O Tires pulled up as the first reference. A similar search of the Google internet search engine, also just for

"tires" in the Scottsdale, Arizona area included Big O Tires on the first page of the search results. Bennett Tr. 71:16-73:17, OX32A-B.

Big O Tires advertises in many different media: anything from print and run of press, to newspaper style advertisements, and direct mail advertising. Big O Tires also utilizes consumer relationship management advertising, which is in the nature of a postcard-style direct mailing that is customized to the individual consumer. Frequently, Big O Tires uses "go-get" materials, which includes anything from passing out business cards at events, to single sheet flyers distributed at a grocery store or in a parking lot, "penny saver" direct mail pieces, etc. Big O Tires also has published promotional advertising in connection with its products branded under its **BIG O TIRES Mark** in which it has offered consumer rebates, and similar promotional programs. In addition to advertising to the direct consumer market, Big O Tires also advertises and promotes new franchise opportunities. Bennett Tr. 22:11-26:23, OX9A-9F.


Every piece of advertising published by Big O Tires contains the **BIG O TIRES Mark**. If the advertisement features Big O Tires's own **BIG FOOT** branded tire line, the advertisement will utilize Big Foot's Sasquatch image, or its **BIG FOOT COUNTRY** logo or the **BIG FOOT** mark. Bennett Tr. 21:18-22:10, *See e.g.*, OX3, OX4, OX7A-7G, OX-9A-F, OX34A-D.

Big O Tires also produces and utilizes television (including cable television) and radio broadcast advertising. In 2007, Big O Tires produced and ran 45th Anniversary celebration radio and television advertising spots in a number of states, including Arizona, California and Oklahoma. The commercials are designed by Big O Tires for a national audience and aired regionally by the franchisees. Recently, Big O Tires hired actor Tom Selleck as its national spokesman and to serve as the voice of Big O Tires. Mr. Selleck was selected because he projects a very honest voice and is

down-to-earth, both qualities which correlate to how Big O Tires likes to conduct its business in the community. Bennett Tr. 23:8-25:14, OX8A-8E.

An independent artist wrote, performed and recorded a song entitled "Under the Big O Sign". Bennett Tr. 73:19-74:1, OX33. The jacket of the CD, which prominently features the "Under the Big O Sign" title song, depicts a couple, standing arm-in-arm underneath a large BIG O TIRES sign, while watching the sun set. OX33.

The **BIG O TIRES Mark** also appears on banners and signage used by Big O Tires franchisees in connection with their local community activities, such as at Little League events, promotional booths at local charity races, and the like. Bennett 16:24-17:8.

Since early 2000, Big O Tires has maintained the Big O Tires Website, which is used to, *inter alia*, advertise tires, wheels, and vehicle maintenance and repair services. The **BIG O TIRES Mark** appears throughout the website. Bennett Tr. 26:25-27:23, OX10. The Big O Tires Website is quite popular, with in excess of  discrete individuals having visited the Big O Tires Website in the four month period between January 1, 2008 through April 24, 2008. Bennett Tr. 28:2-13, OX11. The Big O Tires Website provides individuals interested in purchasing wheels, tires and other automotive products with "how to" purchase information. OX10. The Big O Tires Website also provides individuals with the ability to download discount coupons for use in connection with the purchase of tires and vehicle parts and accessories, as well as maintenance services required for their vehicles. The Big O Tires Website allows customers to directly leave comments, concerns or pose questions to Big O Tires. *Id.*

Big O Tires regularly attracts extensive media attention, as demonstrated from a partial sampling of articles published from 2000-2007. OX 59-64. Articles featuring Big O Tires appear in

many and varied media, including Internet publications, national business journals (e.g., *Entrepreneur*, *Franchise Times*, *Franchise World*), trade publications (e.g., *Tire Business*, *Tire Review*), motor sports racing publications (e.g., *Pacesetters*) and numerous general circulation newspapers of diverse size and location. See e.g. OX16A, 16B, 16D, 21A, 21B, 23, 24A-F, 26A-C, 30; OX 59 – 64.

Big O Tires has long spent enormous sums on promoting the **BIG O TIRES Mark**. Total annual advertising and marketing expenditures, _____

_____ for 1995 through 2008 (partial), alone, were:

<u>Year</u>	<u>Advertising/Marketing Expenditure</u>
1995	\$ _____
1996	\$ _____
1997	\$ _____
1998	\$ _____
1999	\$ _____
2000	\$ _____
2001	\$ _____
2002	\$ _____
2003	\$ _____
2004	\$ _____
2005	\$ _____
2006	\$ _____
2007	\$ _____
<u>2008 (partial)</u>	\$ _____
TOTAL	\$1 _____

Bennett Tr. 29:1-34:23, OX12. Thus, over this time frame, Big O Tires has expended in excess of _____ to promote its **BIG O TIRES Mark**. Obviously, these numbers do not reflect Big O Tires's advertising and promotional efforts during its first three (3) decades of existence.

Over seven years ago, a federal court found that Big O Tires's **BIG FOOT** mark was commercially strong, holding that "substantial sum, spent both locally and nationally and over a period of years, has undoubtedly resulted in increased recognition of Big O Tires's Bigfoot mark." *Big O Tires, Inc. v. Bigfoot 4X4, Inc.*, 167 F.Supp.2d 1216, 1227 (D.Col. 2001).

5. The Big O Tires Success and Public Recognition

Big O Tires has achieved tremendous commercial success – proving that its substantial investment in advertising and promotion, and the goodwill in the **BIG O TIRES Mark** – has translated into actual customer recognition. Since 2001, Big O Tires's total gross sales, **exclusive** of its franchisees' sales, for all merchandise (tires, wheels and accessories, shocks and other merchandise) were:

<u>Year</u>	<u>Sales</u>
2001	\$ [REDACTED]
2002	\$ [REDACTED]
2003	\$ [REDACTED]
2004	\$ [REDACTED]
2005	\$ [REDACTED]
<u>2007 (March)</u> ¹	\$ [REDACTED]
TOTAL	\$ [REDACTED]

Kinnen Tr. 5:1-8:10, OX35A-F.

¹ [REDACTED]
[REDACTED]

The aggregate of sales from all of Big O Tires's franchisees' retail stores for the same period of time, essentially the retail sales of the **BIG O TIRES** "brand" systemwide, were:

<u>Year</u>	<u>Sales</u>
2001	\$ _____
2002	\$ _____
2003	\$ _____
2004	\$ _____
2005	\$ _____
<u>2007</u>	\$ _____
TOTAL	\$ _____

Kinnen Tr. 5:1-8:10, OX12. Since Big O Tires has been operating for over forty-five (45) years, these sales figures represent only a small portion of Big O Tires's total revenues and sales. Indeed, since the essence of the value of a franchise is the brand of the franchise, then these sums may be directly correlated to the **BIG O TIRES Mark**.

Big O Tires's success in meeting the myriad needs of its customers has been well-recognized. For example, in 1995, 1996 and 1998, Big O Tires was awarded "Customer Satisfaction" awards from J.D. Power & Associates for "Best Replacement Tire ~ Passenger Vehicles", beating out competition from other major tire manufacturers, such as Michelin, Goodyear and B.F. Goodrich. J.D Powers & Associates is an international company that assesses and analyzes customer behavior and ranks different product categories and different businesses based on its assessment and analysis. Bennett Tr. 38:1-39:5, OX15A-C.

Big O Tires also has received recognition and accolades from others in the business community. For example, *Entrepreneur* magazine which in its January 1999 issue, marking the 20th annual "Franchise 500" edition, ranked Big O Tires as No. 1 in the overall tire franchisers category,

and 73rd out of 500 in its national Franchise 500 Review, across all businesses. Bennett Tr. 39:15-40:12, OX16A. In 2002, Big O Tires again was ranked as No. 1 in the tire franchisers category by *Entrepreneur*. Bennett Tr. 41:14-42:6, OX16D.

While Big O Tires routinely is ranked as No. 1 in the overall tire franchise category, Big O Tires ranks very well, even when measured against other industries. For example, the publication *Franchise Times* annually ranks the top 200 national franchise chains, across all industries. Big O Tires was ranked as No. 100 (in 2000), No. 95 (in 2001), and No. 154 (in 2004). Bennett Tr. 40:13-42:5, OX16B-C.

Mr. Norman Affleck, one of the founding fathers of Big O Tires, recently was inducted into the Tire Industry Association Hall of Fame. Another of Big O Tires's founding fathers, Mr. William Thomas, also has been inducted into the Tire Industry Association Hall of Fame. Of course, Mr. Affleck's induction was the subject of medial attention. Bennett Tr. 55:1-56-1, OX 23.

One of the ways the **BIG O TIRES Mark** is publicized is through sports sponsorships. Big O Tires has been a sponsor of the Colorado Rockies Major League Baseball team since 2003. The **BIG O TIRES Mark** is featured prominently in signage located at Coors Field in Denver, Colorado, where the Colorado Rockies play. The **BIG O TIRES** sign, which is 11'4½" high x 27'8" wide, is located in a very advantageous position for Big O Tires: in center field above the home and visitor's bullpens. Thus, Big O Tires receives maximum television and stadium exposure every time there is a homerun; if the game is televised and the homerun goes out dead center field, the **BIG O TIRES** sign is clearly visible on every highlight reel. Other than the actual scoreboard at Coors Field, the **BIG O TIRES** sign is the largest single sign in the stadium. It is estimated that Coors Field averages about two (2) million visitors a year. Additionally, games played at Coors Field are

televised on Fox Sport Network, as well as the visiting team's local television networks. Moreover, features and highlights of the games, especially the home runs and other key plays, are broadcast on ESPN, Sports Center, various local news stations, and similar programs. Bennett Tr. 43:14-17, 52:16-54:25, OX22A-C.

Big O Tires has a relationship with the National Hot Rod Association ("NHRA") racing circuit, and sponsors three (3) cars, including an alcohol-fuel dragster, as well as pro-stock cars in the NHRA's professional series. The dragster and stock cars are painted in Big O Tires's company colors of red, black and white, and prominently display the **BIG O TIRES** Logo, the theme of which is carried over onto the uniforms worn by the driver and pit crew, and on promotional signage displayed in various speedways where the vehicle is racing. Big O Tires's dragster race team has been featured in various publications, including *Pacesetters* magazine. The NHRA events in which Big O Tires's sponsored cars participate appear on cable television.

Big O Tires also is an advertising sponsor at the Bandimere Speedway outside of Denver, Colorado. As a sponsor, there is a link on the Bandimere Speedway website to the Big O Tires Website, and Big O Tires is entitled to display its **BIG O TIRES** banners on the retaining wall and elsewhere throughout the facility, as well as on booths (which also distribute customer handouts and other take-home pieces such as pens, pads, coupons, etc.) and trailers parked at the events.

Big O Tires's Northern California franchise group is a sponsor at the Infineon Raceway, also entitling it to an active link on the Raceway's website. Infineon garners a great deal of exposure for the **BIG O TIRES** Mark and branded products, particularly since the **BIG O TIRES** Logo appears directly next to the primary sign for the raceway itself, as well as on the sidewall of the track that frames the track.

Annually, the Northern California Big O Tires franchise group sponsors an event, "Hot August Nights" – a week-long event that brings together car collectors and automotive fans from across the country. Big O Tires has a very large booth at this event, and works in conjunction with many of its custom wheel vendors, American Racing, Wheel Pro, etc., which also provide displays at this event. Big O Tires's booth is staffed by both corporate, as well as franchisee employees, throughout the entire week to support and promote the **BIG O TIRES** brand in the regional community. Bennett Tr. 43:14-52:14, OX17A-B, OX18A-B, OX19A-B, OX20A-C, OX21A-B.

Big O Tires's Lexington, Kentucky franchise group has aired Big O Tires radio advertisements and promotions during live broadcasts of the games of the Indianapolis Colts professional football team on the Colts' radio network. Bennett Tr. 45:1-5.

6. Big O Tires in the Community

An important part of Big O Tires's commitment to the communities it serves includes its sponsorship of, and activities in connection with, various charities and other public service organizations. Bennett Tr. 56:2-70:13, OX24A-30.

For example, Big O Tires is a national sponsor of Alex's Lemonade Stand, the primary focus of which is research for pediatric cancer. The charity was founded by a young girl named Alex Scott who, at age four (4), while suffering from an aggressive form of childhood cancer, began raising funds for research with her own lemonade stand. Bennett Tr. 56:2-57:9. This charity has received extensive national attention: several years ago, one of the major national horse races was won by a horse whose owners donated much of their winnings to the charity; it also has been featured on the Oprah Winfrey television show. Big O Tires has designated July as "Alex's Month" during which its more than 540 stores host actual lemonade stands where customers can make donations. Big O Tires

has distributed Country Time® lemonade coupons to consumers for lemonade in exchange for donations to Alex's Lemonade Stand. Big O Tires also prints and provides envelopes at each of its franchisee's stores so that customers can take home the envelope and make donations as they wish. At the corporate level, alone, over the course of past few years, Big O Tires donated \$50,000 *per year* to Alex's Lemonade Stand Foundation, separate and distinct from monies raised from customer contributions. Big O Tires's contributions to the Alex's Lemonade charity have been featured in numerous newspapers in the local communities where its franchisees are located, as well as nationally. The **BIG O TIRES Mark** also is featured on the website for the Alex's Lemonade Stand Foundation, as well as the Foundation's newsletter, the *Lemonade Gazette*, which is sent out to all its subscribers. The Alex's Lemonade website also includes a link for consumers to find the nearest Big O Tires retail location. Bennett Tr. 57:10-61:25, OX24A-24F.

Big O Tires also has been a sponsor – nationally and locally – of fundraising for the Susan G. Komen Breast Cancer Foundation. In 2006, Big O Tires sponsored a booth at the Colorado Race for the Cure, at which the **BIG O TIRES Mark** was prominently featured on banners, as well as on Big O Tires t-shirts worn by walkers from the Big O Tires team. Bennett Tr. 62:2-25, OX25A-C.

Following the ravaging effects of Hurricane Katrina in 2005, Big O Tires, with the support of its franchisees, donated \$65,000 to the American Red Cross to support efforts to assist and aid the survivors. A number of franchisees ran events to promote individual contributions by their customers and/or to collect donations. Big O Tires's post-Katrina donation to the Red Cross was featured in the November 2005 issue of *Franchising World*. Other articles were featured in the *Wickenburg Sun* (Arizona) in September 2005, as well as numerous other newspapers in cities where Big O Tires franchisees are located. Bennett Tr. 63:1-65:9, OX26A-C,27.

Big O Tires espouses to its franchisees the importance of contributing to their local community. Accordingly, in addition to Big O Tires's direct corporate financial contributions and the coordination of national campaigns for its franchisees, Big O Tires corporate staff exemplifies this spirit. For example, in addition to the above, Big O Tires also is a corporate sponsor for the Juvenile Diabetes Research Foundation, and sponsors a team for its annual Walk to Cure Diabetes. The **BIG O TIRES Mark** is prominently featured on the t-shirts worn by the Big O Tires team. Bennett Tr. 65:11-66:6, OX28. Other charities which Big O Tires has sponsored, locally and regionally, include Habitat for Humanity, and the Denver Food Bank. *Id.* Annually, Big O Tires, through its Big O Tires Scholarship Fund, awards college scholarships which are funded by donations from Big O Tires, its Big O Tires franchisees and franchise employees. Bennett Tr. 69:8-25, OX30. Big O Tires supports other scholarship funds, as well. Bennett Tr. 70:1-13.

Big O Tires's Colorado franchisees have collaborated with local television Channel 9 News in a program, "Treads for Threads" as part of a statewide winter clothing drive. In 2007, in its first year, the drive gathered over 5,800 pounds of clothing, which was distributed to over 1,200 persons in need; the goal in 2008 is 10,000 pounds. The **BIG O TIRES Mark** is featured on the website header for the Treads for Threads program, above the designation for the local television station. Bennett Tr. 66:7-69:6, OX29.

B. APPLICANT

The Applicant, Wheel Specialties, sells wheels, including under the BIGG WHEELS mark. The dominant portion of the opposed BIGG WHEELS mark is the term "BIGG." OX40, no. 115.²

Applicant's selection and use of the BIGG WHEELS mark for wheels and the filing of the opposed application was made with actual knowledge of Big O Tires, its **BIG O TIRES Mark**, business, stores and/or registrations. For example, prior to Applicant's selection of the BIGG WHEELS mark for wheels, Applicant had actual knowledge of Big O Tires and its stores where the **BIG O TIRES Mark** is displayed. OX40, nos. 6-7. Indeed, prior to the selection of the BIGG WHEELS mark, Applicant had visited Big O's Tires stores. OX40, no. 8. Similarly, prior to filing the opposed BIGG WHEELS application, Applicant had actual knowledge of Big O Tires, the **BIG O TIRE Mark**, Big O Tires's pleaded registrations, and Big O Tires's stores. OX40, nos. 10-11, 15-16. As noted above, by this time, Applicant had actually visited Big O Tires's stores. OX40, no. 17. Finally, prior to using the opposed BIGG WHEELS mark, Applicant had actual knowledge of Big O Tires, Big O Tires's **BIG O TIRES** stores, **BIG O TIRES Mark** and pleaded registrations. OX 40, nos. 19-20, 24-25. Prior to using the opposed mark, Applicant had visited Big O Tires's stores. OX 40, no. 26. Indeed, as late as 2002, Wheel Specialties had engaged in business relations with Big O Tires, selling wheels under the QUANTUM TECH brand to a Big O Tires franchisee. See OX39, no. 10; and OX42, no. 10.

Applicant's BIGG WHEELS wheels are marketed and sold in the automotive aftermarket, OX 40, nos. 90-91, as are generic vehicle tires and wheels. OX40, nos. 92-93. Applicant's BIGG

² Indeed, Applicant's BIGG WHEELS wheels have been promoted and sold under the single word mark "BIGG" (*i.e.*, without the word "wheels"). OX40, no. 43,45, 47, 49. In those instances where the generic word "wheels" accompanies the BIGG mark on Applicant's products and promotional materials, the term "BIGG" is presented in a larger size lettering than the word "WHEELS." OX40, nos. 116, 118.

WHEELS wheels are sold by third parties, OX 40, no. 28, a majority of whom also sell tires, automotive parts and accessories, and who offer automobile repair and maintenance services, including tire-related automotive services. OX39, no. 23; OX40, nos. 120, 121-126. Applicant's BIGG WHEELS wheels have been, and are, sold on the websites of third parties.³ OX 40, nos. 28-32, 34-37, 39.

III. ISSUES

(1) Does the BIGG WHEELS mark as used in connection with wheels create a likelihood of confusion with Opposer's prior and famous **BIG O TIRES Mark** for tires, retail store services for wheels, tires, and automotive products, automotive maintenance and repair services, including wheel and tire installation, and stores, *see* 15 U.S.C. § 1052(d); and

(2) Will the BIGG WHEELS mark as applied to wheels dilute the distinctive quality of the **BIG O TIRES Mark**, *see* 15 U.S.C. § 1125(c);

Since Applicant has not pleaded (nor proffered evidence in support of) any counterclaim, these issues are the only questions presented herein.

³ Indeed, the term "BIGG" on one third party website acts as hypertext link for Applicant's BIGG WHEELS wheels. OX40, nos. 40 and 41.

IV. ARGUMENT

A. THE RECORD ESTABLISHES, BY A PREPONDERANCE OF THE EVIDENCE,
A LIKELIHOOD OF CONFUSION BETWEEN OPPOSER'S **BIG O TIRES**
MARK AND THE OPPOSED BIGG WHEELS MARK

Since Big O Tires has introduced into evidence its (mostly incontestable) registrations, "priority" is not an issue in this proceeding. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1167 (TTAB 2001). Therefore the sole issue under Opposer's §2(d) claim is whether there is a likelihood of confusion. A determination of likelihood of confusion in the context of the registrability of a particular mark is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on the issue. *Miles Labs. v. Naturally Vitamin Supplements*, 1 U.S. P.Q.2d 1445, 1450 (T.T.A.B. 1987). The thirteen (13) factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (the *du Pont* factors) frequently are referred to as a fairly exhaustive list of such *potentially* relevant factors.⁴ However, not every factor is

⁴These factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity of the goods/services as described in an application or registration or in connection with which a prior mark is used;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing;
- (5) the fame of the prior mark (sales, advertising, length of use);
- (6) the number and nature of similar marks in use on similar goods;
- (7) the nature and extent of any actual confusion;
- (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
- (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark);
- (10) the market interface between applicant and the owner of a prior mark (i.e., issues of consent, laches,

pertinent to, nor must each of these factors be considered in, each and every case; rather, particular application of these "factors varies from case to case depending on their materiality, relevancy, and merit." *Miles Labs.*, 1 U.S.P.Q.2d at 1450, n.23.

Based on the evidence of record the following factors are pertinent and strongly weigh in favor of a finding of likelihood of confusion.

1. The Fame of the BIG O TIRES Mark Is an Overriding Consideration on the Determination of Likelihood of Confusion.

This factor plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection. *Kenner Marker Toys v. Rose Arts Industries*, 936 F.2d 350, 352, 22 U.S.P.Q. 2d 1453 (Fed. Cir. 1992). The evidence overwhelmingly establishes the fame and recognition of the **BIG O TIRES Mark**. Therefore, the **BIG O TIRES Mark** is entitled to broad protection. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1376, 63 U.S.P.Q.2d 1303 (Fed.Cir. 2002). Indeed, "the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls." *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453 (Fed.Cir. 1992). See also *Proquest Information and Learning Company v. Jacques R. Island*, 83 U.S.P.Q.2d 1351 (T.T.A.B. 2007)⁵

estoppel, etc.);

- (11) the extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) the extent of potential confusion; i.e., whether de minimus or substantial; and
- (13) any other established fact probative of the effect of use.

The last two factors, however, appear to be "catch all" restatements of the ultimate legal issue of likelihood of confusion.

⁵The opposer in *Proquest* had demonstrated the fame of its mark "measured by the length of time the mark has been in use, the volume of sales and advertising expenditures, as well as the widespread unsolicited media attention it has

("Our primary reviewing court has determined that the fame of an opposer's mark plays a 'dominant role in the process of balancing the du Pont factors.'")

Big O Tires has used its **BIG O TIRES Mark** for more than 45 years, and its "founding fathers" have been inducted into the Tire Industry Association Hall of Fame⁶. The **BIG O TIRES Mark** is well-known within and without the automotive industry. Moreover, Big O Tires has expended dollars in advertising, promotion and marketing of its vehicle products and services in connection with its **BIG O TIRES Mark**, resulting in dollars of sales. Bennett Tr. 29:1-34:23, OX12; Kinnen Tr. 5:1-8:10, OX35A-F. As a result, confusion is likely to arise from Applicant's use of the mark which is the subject of the opposed application. *Bose Corp.*, 293 F.3d at 1371 ("[F]amous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. ... [O]ur cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident."). Additionally, Opposer is the owner of no less than fifteen (15) active, pleaded registrations for its trademarks and service marks in connection with tires, retail store services and vehicle services. OX 43-50, OX52-58. Applicant seeks registration of the nearly identical mark, **BIGG WHEELS**, for nearly identical goods, namely, wheels. In a "correct assessment of the *duPont* factors, the fame of [Opposer's **BIG O TIRES Mark**] should have magnified the significance of these similarities." *Kenner Parker Toys*, 963 F.2d at 355.

garnered." *Id*

⁶ The existence of an informal, secondary market in Big O Tires vintage paraphernalia as well as more recently produced items is suggestive of a famous brand.

The **BIG O TIRES Mark** is inherently distinctive mark for purposes of registration on the Principal Register. *Toro, supra* at 1177. Its famous marks are the subject of numerous of its pleaded incontestable registrations, the oldest dating back nearly thirty-five (35) years. This establishes, conclusively, that Opposer's marks are valid and distinctive. 15 U.S.C. § 1065. *Cf. Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 26 U.S.P.Q.2d 1583, 1586-87 (2d Cir. 1993; *The Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 39 USPQ.2d 1511 (2nd Cir. 1996).

As the Federal Circuit noted:

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbol to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys v. Rose Art Industries, 963 F.2d at 353. There can be no serious dispute, on this record, that the **BIG O TIRES Mark** is "very distinct", the subject of "enormous advertising investments," and "a product of lasting value." *See also McDonald's Corp. v. McKinley*, 13 USPQ 2d 1895 (TTAB 1989) ("Clearly, the more extensive the advertising and promotion of a mark, the more well known and likely to be recognized is that mark...").

Accordingly, Opposer's **BIG O TIRES Mark** is entitled to the broadest possible scope of protection available, reducing the quantum of evidence of the remaining factors necessary to establish a likelihood of confusion. *See, e.g., Kenner Parker Toys, Inc.*, 963 F.2d at 352-3.

**2. The Opposed BIGG WHEELS Mark Is Virtually
Identical to Big O Tires's Famous BIG O TIRES Mark.**

Applicant's BIGG WHEELS mark is virtually identical to Opposer's BIG O TIRES Mark in sight sound, meaning and overall commercial impression.⁷ Indeed, the only difference between the distinctive portions of the two marks is the repetitive second letter "g" in Applicant's Mark. However, this slight difference is essentially invisible, inaudible and irrelevant. *Baker v. Master Printers Union*, 47 U.S.P.Q. 69 (D.N.J. 1940) ("Of course, few would be stupid enough to make exact copies of another's mark or symbol. It has been well said that the most successful form of copying is to employ enough points of similarity to confuse the public with enough points of difference to confuse the courts."). To the extent that any consumer recognizes the repetitive second letter "g", this only enhances confusion since the shape of the letter "G" and the letter "O" is quite similar. Alternatively, the term "BIGG" may be viewed as a non-standard version of the word "BIG".

Moreover, when the BIGG WHEELS and BIG O TIRES marks are viewed in their entirety, the confusing similarity is apparent. Indeed, even the non-distinctive portions of the parties' respective marks are closely similar in connotation and/or are highly related in the mind of the consuming public, and further underscore the confusing similarity.

The near identity between the parties' marks is not surprising since Applicant's selection and use of the BIGG WHEELS mark for wheels and the filing of the opposed BIGG WHEELS

⁷This is true whether the comparison is between the distinctive portions of the parties' respective marks or the entirety of the parties' respective marks. For example, the distinctive portion of Applicant's BIGG WHEELS marks is "BIGG". See OX40, no. 115 (Applicant has admitted that the dominant portion of the opposed BIGG WHEELS mark is the term "BIGG."); OX40, nos. 113-4 (the term "wheels" is expressly disclaimed in the opposed application); OX40, no. 43, 45, 47, 49, 116, 118 (Applicant's BIGG WHEELS wheels have been promoted and sold under the single word mark "BIGG" (i.e., without the word "wheels"); and in those instances where the generic word "wheels" accompanies the BIGG mark on Applicant's products and promotional materials, the term "BIGG" is in a larger size lettering than the word "WHEELS."). The term "BIGG" is virtually identical to the term "BIG O".

application was made with actual knowledge of Big O Tires and its **BIG O TIRES Mark**, stores, business and/or pleaded registrations,. OX 40, nos. 6-7, 10-11, 15-16, 19-20, 24-25. Indeed, prior to the selection and use of the **BIGG WHEELS** mark and the filing of the **BIGG WHEELS** application, Applicant had visited Big O Tires's stores. OX 40, nos. 8, 17, 26.

Opposer respectfully submits that to refuse to hold that, at least, **BIGG WHEELS** and **BIG O TIRES** are confusingly similar in sight, sound, meaning and commercial impression, in effect, would be to confine Opposer's trademark rights to absolute, identical copying. There is no basis for such a limitation of Opposer's rights. This factor weighs in favor of a finding of likelihood of confusion.

A "strong mark...casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353. See also *McDonald's Corporation, v. Dorothy Jill McKinley d.b.a. McKinley & Co.*, 13 USPQ2d 1895 (TTAB 1989) ("case law holds that a well-known or famous mark is entitled to a broader scope of protection than one which is relatively unknown"); *Nina Ricci S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.P.S.Q.2d 1901 (Fed. Cir. 1989). Thus, the fame and strength of the **BIG O TIRES Mark**, as well as the near identity of the respective goods, services, business, trade channels and customers of the parties, dictates a lesser showing of similarity of the marks to support a finding of likelihood of confusion. *Kenner Parker Toys*, 963 F.2d at 355.

A competitor can quickly calculate the economic advantages of selling a similar product in an established market without advertising costs. These incentives encourage competitors to snuggle as close as possible to a famous mark. This court's predecessor recognized that a mark's fame creates an incentive for competitors "to tread closely on the heels of [a] very successful trademark." . . . Thus, the Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. As a mark's fame increases, the Act's tolerance for similarities in competing marks falls.

Id. See also *McDonald's, supra* ("Clearly, the more extensive the advertising and promotion of a mark, the more well known and likely to be recognized is that mark and the more likely it is that it will be confused with a similar mark used on similar or related goods."). However, rather than heed this dictate and give the wide berth due to Big O Tires's famous **BIG O TIRES** Mark, Applicant chose to "snuggle as close as possible to [this] famous mark." *Id.* This the Lanham Act cannot properly tolerate.

3. The Goods Set Forth in the Opposed BIGG WHEELS Application Are Identical and/or Closely Related to Big O Tires's Goods, Services and Business

In considering the registrability of a mark, it is the identification of goods as set forth in the opposed application which controls the consideration of, *inter alia*, the similarity or relatedness of the parties' goods. See *Miles Labs. v. Naturally Vitamin Supplements*, 1 U.S.P.Q.2d at 1450 (cases cited).

Big O Tires's registrations cover, and Opposer uses, the **BIG O TIRES** Mark in connection with, tires, retail stores which sell, *inter alia*, wheels, tires, and vehicle accessories, and offer vehicle servicing, repair and maintenance services, including the installation of wheels and tires. The goods set forth in the opposed application are "wheels". Patently, Applicants' goods are identical and/or closely related to Opposer's **BIG O TIRES** products, service and business.

Accordingly, this factor weighs heavily in favor of a finding of likely confusion.

4. The Channels of Trade and Customers for the Goods in the Opposed Application and Those for Opposer's BIG O Tires Goods, Services, Stores and Business Are Identical

Since the opposed application contains no restrictions or other qualifying language to limit the channels of trade, it also must be "presume[d] that the goods move in all channels of trade that

are appropriate for goods so identified and may be sold to all classes of purchasers." *Miles Labs, supra*. Thus, Applicants's goods are presumed to be marketed and sold through, *inter alia*, retail stores featuring automotive aftermarket parts and accessories – the very type of store of which Opposer owns and franchises. Likewise, Opposer's **BIG O TIRES Mark** and incontestable registrations must be accorded the same breadth. *Bongrain International v. Moguet*, 230 U.S.P.Q. 626, 628 (T.T.A.B. 1986):

[I]n the absence of a restriction in the identification as to type of goods, channels of trade, or classes of purchasers, the presumptions afforded to a registration under Section 7(b) of the Trademark Act of 1946 include a presumption of use on all goods comprehended by the identification in all of the normal markets or channels of trade for such goods to all potential purchasers therefor.

However, even without these presumptions of law, Applicant has admitted that tires and wheels are sold in the automotive aftermarket and through similar trade channels. OX40, 98-9. Applicant has admitted that BIGG WHEELS wheels are marketed and sold in the automotive aftermarket, OX 40, nos. 90-91, as are generic vehicle tires and wheels. OX40, nos. 92-93. Moreover, Applicant's BIGG WHEELS wheels are sold by third party retail outlets, OX 40, no. 28, a majority of whom also sell tires, automotive parts and accessories, and who offer automobile repair and maintenance services, including tire-related automotive services. OX39, no. 23; OX40, nos. 120, 121-126. Accordingly, Applicant's BIGG WHEELS wheels are sold in the same commercial setting as Big O Tires's tires, wheels, and automotive services.

Applicant's BIGG WHEELS wheels have been, and are, sold on the websites of various third parties. OX 40, nos. 28-32, 34-37, 39. Similarly, wheels are sold and installed at BIG O TIRES locations. Bennett Tr. 9:21-24, OX3, OX40, nos. 52-53. Moreover, wheels are promoted on Big O Tires's Website. Bennett Tr. 27:15-16, OX10, OX40, no. 54.

Furthermore, Applicant admits that purchasers of wheels for automobiles also purchase automobile tires. OX40, no. 108.

As discussed above, Big O Tires's mammoth marketing efforts pre-empt most means of advertising and promotion. With an annual advertising budget exceeding _____ Big O Tires advertises in numerous media. In short, the **BIG O TIRES Mark** and name is ubiquitous. Thus, any sustained marketing efforts by Applicant will, of necessity, bump into Big O Tires's massive marketing efforts.

5. Applicant Adopted Its BIGG WHEELS Mark with Full Knowledge of Opposer's BIG O TIRES Mark

Even accepting Applicant's claimed date of first use as true, Applicant did not adopt the opposed mark until about thirty (30) years after Opposer's *first* incontestable registration issued; and about forty (40) years after Opposer first used its **BIG O TIRES Mark**. Thus, Applicant had three decades of constructive knowledge of Opposer's **BIG O TIRES Mark**.

More distressing however, Applicant admits that its selection and use of the BIGG WHEELS mark for wheels and the filing of the opposed application was made with actual knowledge of Big O Tires, its **BIG O TIRES Mark**, business, stores and/or registrations. Indeed, prior to the selection, use or filing of an application for the BIGG WHEELS mark, Applicant had visited Big O Tires's stores, wherein the **BIG O TIRES Mark** is conspicuously promoted. Thus, Applicant was not only constructively on notice for decades, but in fact possessed actual knowledge of Big O Tires and its rights for nearly identical marks in connection with nearly identical goods and/or highly related services. This actual knowledge weighs heavily in favor of a finding of likelihood of confusion.

It is well settled that “[a]dopting a designation with knowledge of its trademark status permits a presumption of intent to deceive. . . . In turn, intent to deceive is strong evidence of a likelihood of confusion.” *Interstellar Starship Services, Ltd. v. Epix Inc.*, 184 F.3d 1107, 51 (9th Cir. 1999), *cert. denied*, 528 U.S. 1155, 120 S. Ct. 1161, 145 L. Ed. 2d 1073 (2000).

As aptly stated nearly one century ago:

It is so easy for the honest businessman, who wishes to sell his goods upon their merits, to select from the *entire material universe*, which is before him, symbols, marks and coverings which by no possibility can cause confusion between his goods and those of competitors, that the courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them

Florence Mfg. Co. v. J. C. Dowd & Co., 178 F. 73 (2d Cir. 1910) (emphasis supplied). It is undisputed (and indisputable) that Applicant knew of Big O Tires, Big O Tires’s **BIG O TIRES** Mark and stores, before selecting and using its own nearly identical mark for wheels which are virtually identical (tires) and very similar/highly related (retail store services featuring wheels and tires, wheel and tire services, automotive services) to the goods and services offered under Opposer’s marks. While having before it the “entire material universe,” Applicant chose – with full knowledge of Opposer’s rights – a nearly identical mark for nearly identical goods.

The logical implications of, and legal presumptions arising from, Applicant’s selection and use of a nearly identical mark for identical goods *after* it was aware of Opposer’s marks is clear and support a finding of likely confusion, Applicant’s protestations (if any) to the contrary. *Premier-Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn. 1935) (“Consequently, when we find a newcomer in the field claiming to build for himself an identity depending upon subtle associations

which in fact impinge upon those already established by the plaintiff, protestations of innocent intent overtax the credulity.”)

Moreover, it is axiomatic that “Applicant is not in any case absolved from the duty imposed by our trademark law on all latecomers to select marks for their new products that are sufficiently distinguishable from marks in respect of which others have federally recorded superior rights to prevent confusion.” *Miles Labs. v. Naturally Vitamin Supplements*, 1 U.S.P.Q.2d at 1450. As the Second Circuit stated, “In this circuit and others, numerous decisions have recognized that the second comer has a duty to so name and dress his product as to avoid all likelihood of consumers confusing it with the product of the first comer.” *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 758, 126 U.S.P.Q. 310, 312 (2d Cir. 1960). *See also Steelcase, Inc. v. Steelcare, Inc.*, 219 U.S.P.Q. 433, 437 (T.T.A.B. 1983) (Junior user “was under a duty to select a mark sufficiently far afield from that of opposer to avoid any likelihood of confusion and, having failed to do so, is subject to having any doubts on the question (and we entertain few here) resolved adversely to its claims of registerable rights.”).

Despite this requirement, by the time that Applicant filed the opposed application, Opposer’s pleaded registrations had subsisted on the Principal Register, then-imbued with the rights of its incontestable status, for thirty (30) years. Given Applicant’s professed knowledge of Opposer’s rights in its mark, the near identity of the marks, goods, customers and channels of trade, Applicant clearly failed in its “duty to so name and dress his [BIGG WHEELS] product as to avoid all likelihood of consumers confusing it with the [BIG O TIRES] product” of Opposer. *Id.* This factor weighs heavily in favor of a likelihood of confusion.

6. **Any Doubts Must Be Resolved in Favor of Opposer, the Senior User**

Opposer has proffered strong evidence to support a finding of a likelihood of confusion. Indeed, where – as here – the respective marks, goods/services, channels of trade, and customers of the parties are identical and/or highly similar, a finding of likelihood of confusion is established. *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 57 USPQ 2d 1969 (2nd Cir. 2001). This is especially true given the undeniable fame of Opposer's **BIG O TIRES Mark**. See e.g., *Kenner Parker Toys, Inc., supra*, 963 F.2d at 352 (“As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls”).

Moreover, it is well settled that “all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, *especially where the established mark is one which is famous . . .*” *Nina Ricci*, 889 F.2d at 1074 (emphasis supplied), see also *Bongrain International*, 626 U.S.P.Q. at 628 (“we must resolve our doubts on the issue of likelihood of confusion in favor of opposer, the prior user and registrant”). Since Big O Tires is the senior user – by four decades – of a *famous* mark, any doubts must be resolved in favor of Opposer, especially in view of the “long shadow” cast by Opposer’s famous **BIG O TIRES Mark**.

B. DILUTION

In opposition proceedings, the following factors are considered in a determination of a dilution claim:

- (1) Opposer's mark became famous before the priority date which the Applicant is entitled to rely upon,
- (2) Opposer's mark is famous and distinctive, and
- (3) the opposed mark dilutes Opposer's mark.

Toro Co. v. ToroHead, 61 USPQ 2d at 1173-1182.

1. First Dilution Factor – Fame As Of Priority Date – Favors Opposer

The foregoing (in particular, Section II(A), *supra*) amply demonstrates that the **BIG O TIRES Mark** was famous long prior to the priority date of the opposed application, namely its June 18, 2003 filing date.

2. Second Dilution Factor – Fame and Distinctiveness – Favors Opposer.

The FTDA requires that the diluted mark is both distinctive and famous. *Toro, supra*, at 1175-6. In determining whether a mark is distinctive and famous, the Board may consider factors such as; but not limited to -

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;

- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

15 U.S.C. §1125(c)(1) These factors weigh in favor of the fame and distinctiveness of Opposer's

BIG O TIRES Mark.

- a. The **BIG O TIRES Mark** is Both Inherently Distinctive and Has Acquired Distinction.

The **BIG O TIRES Mark** is inherently distinctive for purposes of registration on Principal Register. *Toro, supra* at 1177. Big O Tires owns numerous incontestable registrations subsisting on the Principal Register for the **BIG O TIRES Mark** without any claim of acquired distinctiveness or a disclaimer (other than as to "tires" or a number designation). OX 43-50, OX52-58. Indeed, a federal court found that Big O Tires's **BIG FOOT** marks were "arbitrary, and thus [] quite strong." *Big O Tires, Inc. v. Bigfoot 4X4, Inc.*, 167 F.Supp.2d 1216, 1219 (D.Col. 2001).

- b. The Geographical Extent of Big O Tires's Trading Area

Big O Tires's reach is truly national. It sells automotive products and offers automotive services through a national chain consisting of 540 stores operating in 21 states. In 2002, Big O Tires operated in 21 states. OX1G. Moreover, Big O Tires has operated an Internet website, at www.BigOTires.com since as early as 2000, which is accessible anywhere in the nation. Big O Tires's Website, which promotes various vehicle parts, including wheels, is quite popular, registering over _____ discreet visitors during the first four months of 2008. Bennett Tr. 26:25-28:13, OX10-11. The geographical extent of Big O Tires's trading area weighs in favor of finding dilution.

c. The Other Fame Factors

A brief survey of the relevant statistics indicates that the **BIG O TIRES Mark** satisfies these requirements for fame. Big O Tires is North America's largest independent tire franchiser. It has enormous revenues and advertising numbers. Big O Tires repeatedly has been recognized with "Customer Satisfaction" awards from J.D. Power & Associates for "Best Replacement Tire ~ Passenger Vehicles". Big O Tires regularly occupies the top national ranking in the overall tire franchise category, and ranks well as measured against all other industries.

Big O Tires heavily and regularly advertises on television networks, radio, national and local newspapers, direct mail and Internet. It is extensively involved in promotional activities, including the MLB, NHRA, *etc.*, as well as charitable and public service efforts.

Intense media attention was suggested as an example of "evidence that show the transformation of a term into a truly famous mark. *Toro, supra* at 1181. It is respectfully submitted that Big O Tires has amassed sufficient evidence on this point. *See e.g.* OX16A, 16B, 16D, 21A, 21B, 23, 24A-F, 26A-C, 30; OX 59 – 64. Each year Big O Tires is the subject of countless articles recounting its every move. These articles appear in a wide swath of media, ranging from Internet publications, to national business journals (*e.g., Entrepreneur, Franchise Times, Franchise World*), to trade publications (*e.g., Tire Business, Tire Review*), to motor sports racing publications (*e.g., Pacesetters*) and *numerous* general circulation newspapers of diverse size and location. Such an expansive and constant treatment would be nonsensical if the **BIG O TIRES Mark** were not a famous mark.

The final factor is whether the mark is registered on the Principal Register. As noted above, the **BIG O TIRES Mark** is the subject of fifteen (15) separate registrations, many of which are incontestable. This factor weighs in favor of dilution.

In short, **BIG O TIRES**, in any context, means Opposer, and only Opposer. It is apparent that by any and every measure, Opposer's **BIG O TIRES Mark** is "distinctive and famous," warranting protection under Section 43(c) of the Lanham Act, 15U.S.C. § 1125(c).

3. Third Dilution Factor – There Is a Substantial Likelihood the Opposed Mark Will Be Diluted.

The Board considers several factors under this prong of the analysis including the similarity of the marks, the renown of opposer's mark and whether target customers are likely to associate the products or services, even if they are not confused as to the different origins. *Toro, supra* at 1183. The **BIGG WHEELS** mark is identical or very or substantially similar to the **BIG O TIRES Mark**, as more fully discussed in the prior section on the likelihood of confusion.

Similarly, the **BIG O TIRES Mark** is and has long been a famous mark, as discussed above.

Furthermore, in view of Applicant's knowledge of Opposer Big O Tires, Opposer's **BIG O TIRES Mark** and registrations, the Big O Tires stores (which Applicant had visited), and the Big O Tires Website, Opposer respectfully submits that Applicant selected the **BIGG WHEELS** mark and filed the **BIGG WHEELS** application with an intention to create an association with Big O Tires's famous **BIG O TIRES Mark**.

Moreover, Big O Tires engages in substantially exclusive use of its mark. Applicant seeks to rely on third party references, however, they are not probative since "applicant did not introduce any evidence as to the extent of the third-parties' use and promotion of their marks". *See 7-Eleven, Inc.*

v. *Wechsler*, 83 USQ2d 1715 (TTAB 2007); AX6-10. "Without such evidence, [the Board] cannot assess whether third-party use has been so widespread as to have had any impact on consumer perceptions." *7-Eleven, supra*. Moreover, existence of third party registrations, AX11-21, are irrelevant. *See e.g.*, TMEP §1207.01(d)(iii); *see also*, Sams, "Third Party Registrations in T.T.A.B. Proceedings," 72 Trademark Rep. 297 (1982) ("third party registrations are of extremely limited evidentiary value").⁸ Finally, the "Internet Publications", AX22-52, Applicant sought to introduce by way of Notice of Reliance, pursuant to 37 C.F.R. §2.122(e), facially are not admissible. *See* TBMP §704.08. Accordingly, Opposer moves to strike such evidence.

Finally, the target customers are likely to associate the products and services of the parties, as discussed more fully in the likelihood of confusion analysis above. Additionally, as the Board noted, "courts have observed that 'the closer the products are to one another [in the marketplace], the greater the likelihood of both confusion and dilution.'" *Toro supra* at 1184, n.20. In this case, both parties sell wheels. Indeed, wheels have long been featured in Big O Tires's advertising efforts.

III. OBJECTIONS

In addition to those discussed above, Opposer renews, and asks the Board to sustain, each and every one of Opposer's objections made at trial. *See* Chart of objections, attached hereto as Attachment C.

⁸ Indeed, many of the eleven cited registrations are cancelled (*e.g.*, nos. 772,529; 900,272; 1,388,039), or will be soon (the grace period has ended in no. 2,580,562, and will end soon in no. 2,596,506).

See Exhibit A-C to Joint

Stipulation Regarding Evidence.

IV. CONCLUSION

The record establishes that Opposer's **BIG O TIRES Mark** is distinctive, famous, and strong, and entitled to the broadest scope of protection. Additionally, Opposer's goods and services and those in the opposed application are identical or highly similar, are sold in the same channels of trade, to the same customers under circumstances which only serve to heighten confusion. Applicant selected its mark with full knowledge of Opposer and its rights. In any event, Opposer's pleaded **BIG O TIRES Mark** has been registered for decades, and its fame demands that Applicant steers clear of encroaching on that mark.

All doubts, if there are any, must be resolved in favor of a finding of likelihood of confusion of Opposer's **BIG O TIRES Mark**. Therefore, in this context of objective evidence of use of the mark in the market place, **BIGG WHEELS** is confusingly similar to **BIG O TIRES**. Additionally, Applicants's **BIGG WHEELS** mark dilutes the distinctive quality of Big O Tires's distinctive and famous **BIG O TIRES Mark**. To hold otherwise, would be to limit the scope of Opposer's famous and strong **BIG O TIRES Mark** to virtually identical marks. This is contrary to law. *See Kenner Parker Toys, supra.*

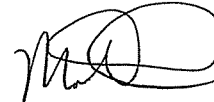
Accordingly, and for all of the foregoing reasons, Opposer respectfully submits that the present opposition should be sustained, and registration of application serial no. 78/264,260 be refused.

Respectfully submitted,

BIG O TIRES, LLC

Date: December 22, 2008

By:



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CERTIFICATE OF SERVICE

I hereby certify that on the 22nd day of December, 2008, I caused a true and correct copy of **TRIAL BRIEF OF OPPOSER WITH ATTACHMENTS** to be served on Respondent, by mailing same, U.S. first class mail, postage pre-paid, to the following:

Donald L. Otto, Esquire
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115-2191



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BIG O TIRES, LLC,

Opposer,

v.

WHEEL SPECIALTIES, LTD.,

Applicant.

Opposition No. 91163791

BIG O TIRES'S TRIAL BRIEF

ATTACHMENT A

Identity of Discovery Response Document	Specific Response Numbers	Trial Exhibit No
Opposer's First Set of Interrogatories	n/a	36
Opposer's Requests for Admissions to Applicant	n/a	37
Opposer's First Request for Production of Documents	n/a	38
Wheel Specialties, Ltd.'s Response to Opposer's First Set of Interrogatories	10, 23	39
Applicant's Response to Opposer's Requests for Admission	6 – 8, 10, 11, 15 – 17, 19, 20, 24 – 26, 28 – 30, 32, 34 – 37, 39 – 41, 43 – 45, 47, 49, 52 – 54, 62 – 64, 78 – 80, 87, 89 – 93, 98, 99, 108, 113 – 118, and 120 – 126.	40
Applicant's Supplemental Responses to Opposer's First Request for Production of Documents	14	41
Applicant's Supplemental Responses to Opposer's First Set of Interrogatories	10	42

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ATTACHMENT B

REG. NO.	ISSUED
993,415	September 24, 1974
994,466	October 1, 1974
1,102,058	September 12, 1978
1,102,059	September 12, 1978
1,611,160	August 28, 1990
1,904,955	July 11, 1995
2,411,926	December 12, 2000
2,514,975	December 4, 2001
2,821,051	March 9, 2004
2,821,052	March 9, 2004
2,821,053	March 9 2004
2,821,054	March 9, 2004
2,821,055	March 9, 2004
2,834,058	April 20, 2004
2,927,656	February 22, 2005

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ATTACHMENT C

**OPPOSER'S OBJECTIONS TO
APPLICANT'S TESTIMONIAL DEPOSITION OF MARK LAMB AND EXHIBITS**

Citation of Objection and Objectionable Testimony and/or Exhibit	Basis
10:6-11:3	Leading
14:23-15:2	Foundation
15:3-17:21 AX3	Leading; Not timely disclosed in discovery: the document was produced on January 28, 2008 (about two weeks prior to the scheduled commencement of trial) in response to document request nos. 38 and 39. The document requests were served on April 19, 2005 and the responsive information covered a time frame of 2004 - 2007. The documents and information should have been produced and disclosed earlier than two weeks before trial in 2008.
22:24-23:25	Foundation; Vague
24:16-24:24	Foundation; Vague
24:25-25:19	Foundation; Vague

Citation of Objection and Objectionable Testimony and/or Exhibit	Basis
26:22-27:1	Leading
25:25-28:12 AX7	Foundation Leading; Speculation; Not produced in discovery (as evidenced by lack of Bates stamp). Opposer's interrogatories (no. 15) and documents requests (no. 60) specifically sought information and documents related to alleged third party uses
28:15-29:16	Foundation
29:17-23	Foundation; Hearsay
29:24-31:12	Foundation; Hearsay; Vague
31:13-20	Foundation; Hearsay
31:21-32:3	Foundation; Hearsay
32:4-13	Foundation; Hearsay
33:10-37:3 AX8	Foundation; Not timely disclosed in discovery (<i>see</i> objection related to Lamb Tr. 15:3-17:21, above).
37:4-38:13 AX9	Foundation; Not disclosed in discovery (<i>see</i> objection related to Lamb Tr. 25:25-28:12, above).
38:22-40:2 AX10	Foundation; Hearsay; Not disclosed in discovery (<i>see</i> objection related to Lamb Tr. 25:25-28:12, above).

Citation of Objection and Objectionable Testimony and/or Exhibit	Basis
40:3-10	[reiterating prior objections]